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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,781	10/30/2006	Warrick J. Smith	E8280.0045/P045	8244
24998 7590 07/14/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
TREYGER, ILYA Y				
ART UNIT		PAPER NUMBER		
3761				
MAIL DATE		DELIVERY MODE		
07/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/544,781

**Applicant(s)**

SMITH ET AL.

**Examiner**

ILYA Y. TREYGER

**Art Unit**

3761

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 6-35 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 36-39 and 41-46 is/are rejected.
- 7) ☒ Claim(s) 44-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/06)  
Paper No(s)/Mail Date 08/08/2005; 10/30/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-46 of the US Patent Application No. 10/544,778 filed 10/30/2006 are presented for examination.

#### ***Claim Objections***

2. Claims 6-35, and 40 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 6-35, and 40 not been further treated on the merits.
3. Claims 44-46 are objected to because of the following reason:

Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table “is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant’s convenience.” Ex parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. See MPEP § 608.01(m).

4. Claims 1-5, 36-39, and 41-46 are examined on the merits.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. See *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993),

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 37-39, 41, 42, and 44-46, are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (US 6,302,122).

9. In Re claims 1 and 2, Parker discloses the apparatus for automatic application of compositions to the skin (tanning booth) having an internal volume and comprising:

a base portion A (Fig. 1) and a top portion B (Fig. 1);

an evacuation fan (Col. 15, lines 15-20), which is a recirculating means for recirculating the air within the booth;

active nozzles 51 (Fig. 1), which are projecting means for projecting product into the booth volume onto a body of a person positioned in the booth (Col. 6, line 55);

an air filter (Col. 15, line 16), which is a filtering means for filtering the air within the booth; and

a controller unit having a feedback mechanisms using sensed temperatures (Col. 15, lines 28-31), which is a temperature means for controlling the temperature of air circulating within the booth.

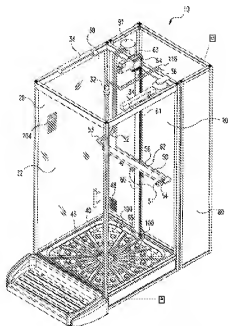


Fig. 1

10. In Re claim 5, Parker discloses the apparatus, wherein the temperature means comprises a heater.

In accordance with the definition controlling means “to adjust to a requirement”.

Adjusting temperature to the requirement (controlling the temperature), as applied to claim 2 above, requires the presence of the heater.

11. In Re claims 36 and 37, Parker discloses the tanning booth comprising an arm 50 and a belt 61 assembly, which is a control system for a booth having projecting means for projecting a product onto the booth volume within the booth, and comprising operating means to operate the projecting means in selected regions of the booth volume (See Col. 6, lines 53-58; Col. 10, line 54; Fig. 1), wherein due to presence of the controlled product delivery system (See Col. 13, lines 18-22) the control system is operable on the projecting means to project specified amounts of the

product in selected regions of the booth volume, the specified amounts vary from zero to maximum flow of the product from the projecting means.

12. In Re claim 38, Parker discloses the tanning booth, wherein the arm comprising nozzles is movable mounted in the booth to be able to move along the path 91 (Fig. 1), and, consequently, the control system operates the projecting means as it moves along the path 91 in accordance with predetermined instructions (See. Col. 6, lines 52-58).

13. In Re claim 39, since the tanning booth is disclosed for applying a product to a human body, Parker discloses a method for applying a product to a human body using a booth discussed above, as applied to claim 1.

14. In Re claim 41, since the tanning booth is disclosed for applying a product to a human body, Parker discloses a method for applying a product to a human body comprising the steps of:  
causing air to flow in a downward direction onto the human body and recirculating the air flowing onto the human body (Col. 15, lines 15-20);

filtering the air to remove wet and dry particulate material (Col. 15, line 16);

projecting a product onto the human body (Col. 6, line 55).

15. In Re claim 42, Parker discloses the method comprising the step of controlling the temperature of the air flow onto the human body (Col. 15, lines 28-31).

16. In Re claim 44, Parker discloses a booth discussed above with reference to the accompanying drawings.

17. In Re claim 45, Parker discloses a tool discussed above with reference to the accompanying drawings.

18. In Re claim 46, Parker discloses a method discussed above with reference to the accompanying drawings.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

22. Claims 3, 4, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker et al. (US 6,302,122).

23. In Re claim 3, Parker discloses the claimed invention discussed above, but does not expressly disclose the particular parameter of the temperature range of the air flow in the booth.

The particular temperature range in the tanning booth depends of the nature of the particular product being disposed into the booth and physical conditions of the particular person to be treated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the temperature rate in the booth depending of the particular product being disposed into the booth and physical conditions of the particular person to be treated, since discovering the optimum or workable ranges involves only routine skill in the art.

24. In Re claim 4, Parker discloses the claimed invention discussed above, but does not expressly disclose the particular parameter of the air temperature in the booth.

The particular parameter of the temperature in the tanning booth depends of the nature of the particular product being disposed into the booth and physical conditions of the particular person to be treated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the temperature rate in the booth depending of the particular product being disposed into the booth and physical conditions of the particular person to be treated, since discovering an optimum value of a result effective variable involves only routine skill in the art.

25. In Re claim 43, Parker discloses the claimed invention discussed above, but does not expressly disclose a computer program product directly loadable into the internal memory of a digital computer, comprising software code portions for performing the steps of the method discussed above.



It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the program product as claimed, since if the computer has been used to operate the claimed method, the computer program product directly loadable into the internal memory of a digital computer, comprising software code portions for performing the steps of the method discussed above is the mandatory requirement for functioning the computer in the claimed direction.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/544,778.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

3. Claim 1 recites “a base portion and a top portion”; “flow means”, “projecting means”, and “control means”, and “filtering means”.

All the elements of claim 1 are to be found in claim 1 of the ‘778. The difference between claim 1 of the application and claim 1 of the ‘778 lies in the fact that the Application claim includes “a filtering means”.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to supply the tanning booth of the ‘778 with the filtering means as introduced in the Application in order to filter the air in the booth.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILYA Y. TREYGER whose telephone number is (571)270-3217. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ilya Treyger/  
Examiner  
AU 3761

/Tatyana Zalukaeva/  
Supervisory Patent Examiner, Art Unit 3761